

**REMARKS**

**Status of Claims**

Claims 1 and 3-8 are pending, of which claim 1 is independent. Claim 2 has been cancelled.

Claims 1, 4 and 5 have been amended to correct informalities in the claim language and to more clearly define the claimed subject matter. Claim 1 has been amended by incorporating all of the limitations of claim 2. Accordingly, claim 2 has been canceled without prejudice. No new matter has been entered.

**Rejections under 35 U.S.C. §§ 102/103**

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nakai et al. (USP 4,828,611) or appeared to be rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai. Applicants respectfully traverse these rejections.

Applicants respectfully submit that amended claim 1 now recites that the binder phase contains at least titanium, of which content in said binder phase is at least 0.5 mass % and less than 20 mass %. Nakai discloses a diamond compact comprising carbide particles selected from a group consisting of WC and (Mo, W)C and iron group metal, and thus fails to disclose titanium in the binder phase as required by claim 1.

To anticipate, every element and limitation of the claimed subject matter must be found in a single prior art reference, arranged as in the claims. *Brown v. 3M*, 265 F.3d. 1349, 60 USPQ2d 1375 (Fed. Cir. 2001). Since, at a minimum, Nakai fails to disclose the above discussed limitations of claim 1, Nakai does not anticipate the subject matter of claim 1 or any dependent claims thereupon. In addition, since Nakai fails to disclose the above discussed

limitations of claim 1, Nakai does not render claim 1 and any dependent claims thereupon obvious. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 3 and 4.

#### **Rejections under 35 U.S.C. § 103**

Claims 2, 5 and 7-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai in view of Hara et al. (USP 4,374,900). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakai in view of Nakamura et al. (JP 09-316587) or Ogata et al. (USP 6,261,329). Applicants respectfully traverse these rejections.

As discussed above, the subject matter of the present application includes that the binder phase contains at least titanium of which content in the binder phase is at least 0.5 mass % and less than 20 mass %. By using titanium as the starting material, improvement in binding strength between the diamond particles and suppression of abnormal particle growth are effectively attained (see, page 7, line 28 to page 8 line 2 and Table 1, sample 1E and 1G of the present application).

Regarding claim 5, the Examiner concedes that Nakai fails to disclose a binder phase containing at least titanium, and asserts that Hara discloses titanium carbide as a base cermet. Applicants, however, submit that Hara fails to disclose the content of titanium in the binder phase is at least 0.5 mass % and less than 20 mass % as recited by base claim 1. As such, the combination of Nakai with Hara fails to disclose the above discussed limitations of claim 5. Further, none of other cited references cures the deficiencies of Nakai and Hara. Thus, the combination of Nakai with Hara does not render claim 5 obvious. Similarly, the combination of Nakai with Hara does not render claims 7 and 8 obvious because neither Nakai nor Hara

discloses the above limitations regarding titanium and its content of base claim 1. Further, regarding claim 6, the combination of Nakai with Nakamura or Ogata fails to disclose the titanium of which content in the binder phase is at least 0.5 mass % and less than 20 mass % because neither Nakamura nor Ogata discloses the above discussed limitations regarding titanium and its content of base claim 1. As such, Applicants respectfully submit that claims 5-8 are patentable over the cited references for at least the reasons set forth above. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 5-8.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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